

REMARKS

Applicants have cancelled Claim 2 without prejudice or disclaimer. Applicants have amended Claim 1, support of the amendment can be found at page 3, lines 9-19. Applicants respectfully submit that no new matter has been added by the present amendment.

I. Claims Rejections - 35 U.S.C. § 102(b)/103(a)

The Office Action rejects Claims 1 and 3-5 under 35 U.S.C. § 102(b) as anticipated by or in the alternative, under 35 U.S.C. § 103(a) as obvious over Vanderbilt, et al. (U.S. Patent No. 3,447,572). Applicants respectfully traverse this ground of rejection, however, Applicants have amended Claim 1 to include the limitations of Claim 2, which is not rejected on this ground, accordingly, Applicants request withdrawal of this ground of rejection.

II. Rejection under 35 U.S.C. §103(a)

Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Vanderbilt, et al. in combination with Applicant's own disclosure.

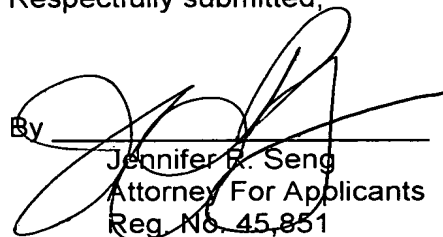
Applicants respectfully traverse this ground of rejection. Applicants also respectfully submit that "in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claims limitations. The teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicants' disclosure." See MPEP § 2142, citing In re Vaeck, 947 F.2d 488, 20 USPQ 2d. 1438 (Fed. Cir. 1991).

The issue of motivation is properly addressed in terms of one of ordinary skill in the art who has not had access to Applicant's Specification. As set forth by the Federal Circuit in In re Dow Chemical, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988) "the consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art". The proper standard clearly required by the Federal Circuit is that "both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure". The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient to establish *prima facie* obviousness.

Applicants submit that the Office Action has not established a prima facie case of obviousness. As stated in the Office Action, "Vanderbilt, et al. differs basically from the claimed invention as per the non-express disclosure of an embodiment directed to the polyvinyl chloride component per the claimed invention as recited in Claim 2." Accordingly, Applicants submit that as stated in the Office Action, Vanderbilet, et al. fails to teach or suggest each claim limitation. According to the Office Action, "it would have been obvious to the skilled artisan following applicants' guidelines at page 3, lines 21-24 to use any commercially available polyvinyl chloride governed by the claimed particle size." Applicants respectfully submit that the Office Action fails to provide any motivation for one skilled in the art to use polyvinyl chloride as presently claimed, the only motivation the Office Action cites to is motivation in the Applicants specification, however as stated above, according to 35 U.S.C. § 103(a), **the prior art references must teach or suggest all the claims limitations** and the teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, **and not based on applicants' disclosure**. Accordingly, Applicants respectfully submit that Vanderbilt, et al. fails to teach or suggest each and limitation of the claimed invention and therefore, Applicants request withdrawal of this ground of rejection.

Respectfully submitted,

By


Jennifer R. Seng
Attorney For Applicants
Reg. No. 45,851

Bayer Corporation
100 Bayer Road
Pittsburgh, Pennsylvania 15205-9741
(412) 777-83
FACSIMILE PHONE NUMBER:
(412) 777-8363

/jme/JRS/JS0143